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Dated: June 26, 2003

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Paul B. Stephens

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Docket No.: 29020/97060A
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
LePage *et al.*

Application No.: 09/205,318

Group Art Unit: 3634

Filed: December 4, 1998

Examiner: Blair M. Johnson

For: ROLL-UP DOOR FOR VEHICLE SHELTERS

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
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Dear Sir:

Pursuant to the Notice of Appeal, mailed February 27, 2003, in connection with the above-identified reissue patent application, applicants respectfully submit the instant Brief on Appeal in accordance with 37 C.F.R. §§1.176 & 1.192.

I. REAL PARTY IN INTEREST

The above-referenced reissue application has been assigned to Rite-Hite Holding Corporation, who is the real party in interest to this appeal. The assignment has been recorded in the United States Patent and Trademark Office at Reel 012616 on Frame 0465.

II. STATUS OF CLAIMS

Claims 1-27 are pending in this application. Claims 1-19 (Appendix A) are the claims originally issued in U.S. Patent No. 5,579,820 (the '820 patent). The remaining claims 20-27 (Appendix B) were added in the reissue application filed under 37 C.F.R. §1.173. The patentability of claims 1-19 has been confirmed. These claims are not at issue in this appeal. Claims 20-27 have been indicated as allowable over the prior art of record,

however, these claims have been rejected under 35 U.S.C. §251 as being improper recapture of subject matter.

Claims 20-27 form the subject matter of this appeal.

A. Original Application

By way of background, the original application resulting in the '820 patent was filed on November 10, 1994. The application contained a single claim, an apparatus claim.

In an Office Action dated February 29, 1996, this claim was rejected under 35 U.S.C. §112, ¶2 as being indefinite. The claim was also rejected under 35 U.S.C. §102 as being anticipated by Belgian Patent No. 533251 (the Belgian patent).

The Office Action based its §112 rejection on confusion stemming from the applicants' recitation of certain subject matter in structural relation to the environment of use recited in the preamble. The preamble recited that the claimed closure was for use in "vehicle shelters of the type defining at a front end thereof a door opening having lateral sides which diverge from top to bottom." The Office Action viewed the claim as a vague and indefinite attempt to claim a device in relation to an unclaimed environment of use.

In a May 29, 1996 response to the §112 rejection, the applicants amended claim 1 and added claims 2-19. Applicants' representative indicated that the amendment to claim 1 was made in response to the rejection under 35 U.S.C. §112. The closure was amended to recite "a closure means having a shape which tapers in a direction of said roller means." The amendment removed a reference to the closure having a shape "substantially complementary to that of the door opening," language the examiner identified as indefinite.

In response to the anticipation rejection, the applicants noted that the Belgian patent disclosed a window opening that was rectangular and a matching screen. This was starkly different from the claimed subject matter, which had a section closing that was complementary in shape to the door opening and thus trapezoidal in shape. Claim 1 was also

distinguished, in part, because it recited a closure with edges tapering towards an overhead roller provided at a narrow end of the shelter opening.

In the May 29, 1996 response, the applicants also distinguished the Klose (U.S. Patent 4,979,775), Ojima et al. (U.S. Patent 5,201,810), Germann (U.S. Patent 2,594,910), Domicent (U.S. Patent 4,231,289), and Lamb (U.S. Patent 3,051,232) patents, as well as a German publication. Klose, for example, did not have guide means mounted to each lateral side of its opening. The Ojima et al. patent and the Germann publication only taught structures with rollers at a large, bottom end of an opening. Neither taught rollers that could be used in a vehicle shelter. Like the Ojima et al. patent and the Germann publication, the Germann patent taught rollers at a large end of an opening and thus did not teach the claimed subject matter. The Domicent and Lamb patents were described as irrelevant to claim 1.

A telephonic interview was held on June 7, 1996. The notice of allowability issued thereafter, on June 11, 1996 allowing claims 1-19. The notice of allowability included an examiner's amendment but provided no statement of the reasons for allowability. The case issued as U.S. Patent No. 5,579,820 on December 3, 1996.

B. Reissue Application

On December 3, 1998, the patent owner filed a broadening reissue application. The statement of error identified erroneous limitations in the issued claims. Generally, the identified errors were a result of the particular environment of use that the applicants sought upon filing. Specifically, the errors identified were in limiting the claimed subject matter to a closure device "for use on vehicle shelters of the type defining a front end thereof a door opening having lateral sides which diverge from top to bottom." The closure device of the invention is not limited to such vehicle shelters and instead may be used in conjunction with any doorway or opening including those that do not have divergent or lateral sides. The issued claims, however, included recitations narrowly directed to the specific environment of use.

On July 20, 2001, a first official action was sent, confirming the allowability of the original issued claims 1-19. Claims 20-27, however, were rejected. First, claims 20-27

were rejected under 35 U.S.C. §112, ¶2 for formality reasons. Second, claims 20-22 were rejected as being anticipated by a Kelley product called Tufflex Beam™. Third, claim 26 was rejected as being anticipated by a patent to Coenraets. Fourth, claims 20-22, 23, and 24 were rejected as obvious over Kraeutler (U.S. Patent 5,477,902) alone or in combination with the Belgian patent, the Tufflex Beam™ disclosure, or the Coenraets patent.

The only other rejection was of claims 20-27 under 35 U.S.C. §251, as being recapture of surrendered subject matter. The Office Action identified three features of the issued claims as removed from the added claims 20-27. The first feature related to the recitation of vehicle shelters in the preamble of the claim. The second feature related to the diverging sides of the closure. The third feature related to diverging guide means.

On January 21, 2002, the applicants filed an amendment to claims 20 and 26 and a response pointing out the errors in the recapture rejection. A second Office Action was mailed on July 11, 2002 reiterating the recapture rejection. The Office Action also rejected claims 20-27 on prior art grounds. The action was made final.

On January 13, 2003, the applicants filed a request for continued examination and preliminary amendment to claims 20 and 26. On January 29, 2003, an Office Action was mailed, again rejecting claims 20-27 based upon recapture. The subject matter of claims 20-27 was otherwise indicated as allowable and subject to no prior art rejections.

A Notice of Appeal was mailed February 27, 2003.

III. STATUS OF THE AMENDMENTS

No amendments have been filed after the appealed January 29, 2003 Office Action, (Paper No. 14), which discussed the current claims provided in Appendix B.

IV. SUMMARY OF THE INVENTION

Although reference numerals and specification citations are inserted below in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Appeal Brief. There is no intention to in anyway suggest that the terms of the claims are

limited to the examples in the specification. Although as demonstrated by the reference numerals and citations below, the claims are fully supported by the specification as required by law, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology, as is done here to comply with Rule 1.192(c), does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the reference numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

A. Independent Claim 20 and Its Dependent Claims

In the subject matter as provided in claim 20, a roll-up closure device (D) adapted to be disposed adjacent a door opening (see, Figure 13, for example) and movable between blocking (Figure 1) and unblocking (Figure 13) positions relative thereto is provided. The closure device includes a roller (32) adapted to be rotatably mountable adjacent an upper end (Figure 4) of the door opening. The closure device further includes a curtain (34) adapted to be secured to a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively. The closure device also includes guide members (22) adapted to be disposed at the lateral sides of the door opening, and guide engagement members (36 or 38) coupled to the curtain for movement therewith and engageable with the guide members to restrict their movement toward the curtain center. The closure device of claim 1 also includes a discrete elastic member (58) coupled to the curtain for movement therewith and extending laterally across the curtain, and disposed such that the elastic member can be stretched laterally (See, Figures 2 & 13) between the restricted guide engagement members.

In the invention as defined in claim 21, the closure device recited in claim 20 is further defined such that the opposed ends of the elastic member are coupled to the curtain, and the restricted guide engagement members are coupled to the lateral edges of the curtain, an increased lateral separation of the guide engagement members exerting a pulling force on the curtain tending to stretch the elastic member. (See, Col. 5, ll. 40-51)

In the invention as defined in claim 22, the closure device recited in claim 20 is further defined such that the elastic member can be stretched to allow the curtain to yield to an applied external force without rupturing. (See, Col. 5, ll. 40-51).

In the invention as defined in claim 23, the closure device recited in claim 20 is further defined such that the guide engagement members (36) are cables extending along the lateral edge of the curtain and received in a pocket formed therein. (See, Col. 5, ll. 8-15)

In the invention as defined in claim 24, the closure device recited in claim 20 is further defined such that the guide engagement members are blocks (38) coupled to the lateral edges of the curtain at approximately the same height as the elastic member. (See, Col. 4, l. 58 – Col. 5, l. 15; See, Figure 2).

In the invention as defined in claim 25, the closure device recited in claim 20 is further defined to include a second elastic member (58) coupled to the curtain for movement therewith and extending laterally across the curtain such that the second elastic member can be stretched between the restricted guide engagement members. (See, Col. 5, ll. 40-41).

B. Independent Claim 26 and Its Dependent Claim

In the subject matter as provided in claim 26, a roll-up closure device (D) adapted to be disposed adjacent a door opening (see, Figure 13, for example) and movable between blocking (Figure 1) and unblocking positions (Figure 13) relative thereto is provided. The closure device includes a roller (32) adapted to be rotatably mountable adjacent an upper end of the door opening. The closure device further includes a curtain (34) adapted to be secured at a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively. The closure device further includes guide members (22) adapted to be disposed at the lateral sides of the door opening; and laterally inwardly biasing means (58) for maintaining the curtain taut, and for allowing the curtain to yield depth-wise for an applied force, wherein the laterally inwardly biasing means is movable with the curtain between the blocking and unblocking positions.

In the invention as defined in claim 27, the closure device recited in claim 26 is further defined such the laterally inward biasing means includes guide engagement members (36 or 38) couplable to lateral edges of the curtain for movement therewith and engageable with the guide members to restrict their movement toward the curtain center. The closure device further includes a discrete elastic member (58) coupled to the curtain for movement therewith and extending laterally across the curtain, and disposed such that the elastic member can be stretched between the restricted guide engagement members. (Col. 5, ll. 40-51).

V. ISSUES ON APPEAL

The issue presented on appeal is as follows:

Do Reissue Claims 20-27 Recite Subject Matter Surrendered During the Original Prosecution?

VI. GROUPING OF CLAIMS

Applicants assert that the claims of the following group stand and fall together:

- a. Claims 20-27.¹

VII. ARGUMENT

A. Claims 20-27 Do Not Contain Subject Matter Surrendered During the Original Prosecution.

1. The Error in the Original Patent Stems from the Environment of Use in the Originally Filed Claim.

The subject matter at issue relates back to the particular environment of use recited in the originally-filed claims. The filed application included a single claim directed to a somewhat specific environment of use, i.e., a roll-up closure device for use in a “vehicle shelter of the type defining at a front end thereof a door opening having lateral sides which diverge from top to bottom.” No other closure devices were ever claimed.

¹ Originally issued claims 1-19 have been allowed and are not at issue in this appeal.

The particular environment of use distinguished over the prior art. For example, there was art that failed to teach vehicle shelters. There was also art that failed to teach door openings that diverged from top to bottom. Thus, in responding to the art rejections, the applicants pointed to claim elements some of which were recited in structural relation to the environment of use. Some of the highlighted claim elements, however, were not related to the environment of use. Simply put, the applicants identified numerous distinguishing features, some of these distinctions related to the closure means, some to the guide means, and some to neither.

At no time were the claims now sought part of the disposition of the original application. The present claims (see, Appendix B) are directed to a broader class of closure devices that may be used on structures other than vehicle shelters and on door openings other than those that diverge from top to bottom. Such environments of use were not contemplated by the applicant during the original prosecution. No claims were presented to them. And, at no time did the applicants or the examiner discuss the possibility, much less the patentability, of such subject matter.² What is now sought simply was not at issue. *

The applicant's Statement of Error (attached at App. C) identifies the originally intended environment of use as the source of the errors making the claimed subject matter unjustly narrow. Specifically, the applicants argue that the claimed closure device need not be "typically for use on vehicle shelters," as recited in the original claim, and that the device need not be limited to those vehicle shelters having doorway openings with lateral sides "which diverge from top to bottom." Both features were in the preamble of the originally filed claim and, as a result, both features affected those claim limitations that were recited in structural relation thereto.

In contrast to the issued claims, the presently-sought claims are directed to different, broader subject matter, as follows:

² The examiner states that the applicants did not argue the shortcomings of the prior art environments of use, although none related to vehicle shelters. The applicants do not believe that conclusion follows from the record. The applicants did distinguish environments of use that were rectangular as well as those that were trapezoidal but with rollers at bottom edges instead of top edges. In any event, the fact that the prior art did not show environments of use like those in the claimed preamble merely confirms the applicants' position that the present environments of use were not contemplated, or at issue, during the original prosecution. Thus, no competitor reading the prosecution history would think they were surrendered.

20. A roll-up closure device <u>adapted to be</u> disposed adjacent a door opening and movable between blocking and unblocking positions relative thereto, and comprising:	26. A roll-up closure device <u>adapted to be</u> disposed adjacent a door opening and movable between blocking and unblocking positions relative thereto, and comprising:
a roller adapted to be rotatably mountable adjacent an upper end of the door opening;	a roller adapted to be rotatably mountable adjacent an upper end of the door opening;
a curtain adapted to be secured to a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively;	a curtain adapted to be secured to a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively;
guide members <u>adapted to be</u> disposed at the lateral sides of the door opening;	guide members <u>adapted to be</u> disposed at the lateral sides of the door opening; and
guide engagement members couple to the curtain for movement therewith and engageable with the guide members to restrict their movement toward the curtain center; and	laterally inwardly biasing means for maintaining the curtain taut, and for allowing the curtain to yield depth-wise from an applied force, <u>wherein the laterally inwardly biasing means is movable with the curtain between the blocking and unblocking positions.</u>
<i>new</i> a discrete elastic member coupled to the curtain for movement therewith and extending laterally across the curtain, and disposed such that the elastic member can be stretched <u>laterally</u> between the restricted guide engagement members.	

Both claims exclude any preamble reference to a vehicle shelter, and both exclude the reference to a door opening having lateral sides “which diverge from top to bottom.” Because these claims are directed to a broader environment of use, they also exclude certain positively recited limitations. For example, claims 20 and 26 remove the following quoted language: the guide means adapted to be mounted to the vehicle shelter substantially at the lateral sides of the door opening and substantially parallel thereto “thereby diverging from top to bottom.” The claims also remove the recitation of the closure means “having a shape which tapers in direction of said roller means.” Claim 20 adds guide engagement members and a discrete elastic member “extending laterally across the curtain.”

Claim 26 adds laterally inwardly biasing means. None of these added features was in the issued claims.

Both claims 20 and 26 have been confirmed as reciting allowable subject matter. In an office action dated July 20, 2001, claim 20 was rejected (1) as anticipated by a Kelley Co. disclosure of a Tufflex Beam™ product and (2) as obvious based on a patent to Kraeutler. Claim 26 was rejected as anticipated by Coenreates. The office action failed to set forth how these documents taught the relevant subject matter and, as such, all three rejections were improper. Each rejection failed to identify elements in the prior art as teaching the claimed subject matter. The impropriety of these rejections was noted in applicant's January 21, 2002 response. In the July 11, 2002 office action, the examiner submitted a subsequent and final office action setting forth the detailed grounds for these rejections. The applicants amended the claims, and the examiner later confirmed that these amended claims recite allowable subject matter, identifying the following reasons for allowability:

The prior art does not teach lateral stretching elastic members or laterally inwardly biasing means being movable with the curtain.

Although independent claims 20 and 26 above (and all remaining claims in the reissue application) have been confirmed as reciting allowable subject matter, the examiner rejects these claims as impermissible recapture. The examiner acknowledges that there was no surrender by amendment or by cancellation—the subject matter now sought was never claimed. Instead, the examiner relies upon the holding in Hester Indus. v. Stein³ and concludes that the applicant surrendered the reissue subject matter by way of argument. *

The applicants respond below (1) that the examiner's characterization of the original prosecution is in error; (2) that Hester is distinguishable on the facts and, thus, inapplicable to the present application; and (3) that, even if argument-based surrender is applicable, the "clear and unmistakable" standard for argument-based surrender has not been met.

³ 142 F.3d 142 (Fed. Cir. 1998).

2. The examiner's Recapture Rejection is Improper

The examiner identifies the removal of two elements from the original claims as being impermissible recapture,⁴ "namely the diverging sides of the closure and the diverging guide means." The examiner argues that these features were the "point of novelty" of the original claims. Of course, this is not the standard for assessing reissue claims.

The question for reissue is not whether the excluded subject matter was necessary for patentability of the original claims. In fact, that could not be the test here, as the examiner has confirmed that the present reissue claims excluding these 'points of novelty' are indeed patentable. The question is not the subjective intent of the applicant, either. Rather, the question is objective and depends upon whether a competitor, reading the prosecution history, would reasonably conclude that the subject matter was surrendered by the applicant. Insituform Technologies, Inc. v. CAT Contracting, Inc., 99 F.3d 1098, 1107-08 (Fed. Cir. 1996).

To focus on a "point of novelty" is completely inappropriate and if left unchecked could completely vitiate the reissue statute.

a. The Applicants Made Numerous Distinctions Over the Prior Art, None of Which Amounted to Surrender of the Now-Sought Subject Matter.

The distinctions made in response to the original rejections were, in part, a function of the impropriety of these rejections. The original application was filed with a single claim. The examiner rejected that claim under 35 U.S.C. §112, ¶2 and under 35 U.S.C. §102. First, the examiner took issue with the applicants' choice to claim a closure means "said to have a shape complementary to the door opening." Per the examiner, language that related a claim element to an environment of use rendered the claim vague and indefinite.⁵

⁴ Per the examiner, the third change was directed to the preamble and thus not claimed subject matter and impermissible recapture.

⁵ The applicants note that there is nothing in the law that prevents an applicant from claiming subject matter in relation to its intended environment of use. In fact, for many manufacturers the only way to avoid the pitfalls and heightened burden of proof for contributory infringement is to obtain claims directed to subcombinations recited in relationship to a particular combination or, in this case, environment of use. Without such an expedient, patentees would be sorely hampered in enforcing their patents directly against certain competitors, often their direct competitors. Instead, patentees would be limited to contributory infringement claims against manufacturers. Contributory infringement is undesirable, of course, because it requires that the patentee prove

Second, the examiner took issue with claim validity and rejected claim 1 as anticipated by the Belgian patent. This rejection was facially improper, however, as it did not link any of the teachings of the prior art to the recited subject matter. The rejection pointed to no specific structure in the Belgian patent and left the applicants to their own devices in determining what to illuminate as distinguishing subject matter. It was in the framework of these improper rejections that the applicants' responses were made.

The examiner suggests that diverging lateral sides on the closure means and on the guide means were the only argued distinctions over the art. The record shows otherwise.

With respect to the guide means, the examiner points to a portion of the prosecution history where the applicants distinguished the Belgian patent. What the examiner fails to acknowledge is that the applicants stated that the Belgian patent taught vertical guide tracks and that these vertical tracks were "similar to those of the present invention." In other words, the applicants recognized that the Belgian patent, although not teaching diverging tracks, nevertheless taught tracks that were similar to that of the claimed subject matter. Guide means diverging from top to bottom was not argued as distinguishing the Belgian patent.⁶ The suggestion that the applicants surrendered guide means subject matter is without merit.

The applicants also did not surrender the suggested closure device subject matter. Contrary to the examiner's contention, numerous distinctions were made over the prior art. Some of the distinctions related to the environment of use set forth in the preamble, others did not. The closure device having diverging lateral sides was merely a distinction. *

With respect to the Belgian patent, the applicants noted that environment of use was quite different. The Belgian patent described a rectangular window, and as such it could not teach an apparatus for use with a door opening having lateral sides that diverged

not only direct infringement by another, but also the absence of any substantial non-infringing use of the subject product. The §112 rejection was improper.

⁶ The claimed guide means, at that time, made no reference to diverging from top to bottom. That feature was added by an examiner's amendment accompanying the notice of allowance.

from top to bottom.⁷ This was the first distinction. The applicants further noted that, although the Belgian patent taught tapered edges on a portion of its screen, these edges did not affect screening and were not comparable to the claimed closure means with diverging sides. The portion of the Belgian patent's screen that actually performed any screening function was rectangular and not capable of use with a door opening having lateral sides that diverged from top to bottom. This was a second distinction. The applicants further noted that the Belgian patent did not disclose a closure having side edges tapering towards "the overhead roller provided at the narrow end" of the door opening. Claim 1 separately recited a roller at the narrow end of the door opening, and that was not taught by the Belgian patent. This was a third distinction.

The applicants never argued that any of these features were required for the invention to be claimed, only that these features distinguished over the Belgian prior art. Furthermore, the three features were not confined to the closure device having diverging lateral sides.

Even if the distinctions over the Belgian patent were related, the applicants identified other claimed features as distinguishing over other art or record, belying any suggestion that diverging lateral sides was the sole distinguishing feature.⁸ The Klose patent, for example, was distinguished as disclosing a structure that did not cover the entire windshield, instead requiring a third screen to cover an increasing middle portion as the sides were brought downward.⁹ In fact, the applicants characterized Klose as teaching trapezoidal shade strips 8, indeed acknowledging that one could interpret the patent as teaching a closable device having diverging edges. The Klose patent was nonetheless distinguished because the Klose strips did not actually close an opening. The applicants' comments on Klose suggest the exact opposite of what the examiner now argues. Diverging lateral sides

⁷ Specifically, the applicants stated on page 6 of their May 29, 1996 response, "as opposed to the present invention, the window opening in Wellens is rectangular and the section of the screen 1 which closes the window opening is thus also rectangular."

⁸ No rejection was based on this art. Instead, the references were cited as teaching "pertinent closures." Despite there being no rejections, the applicants still referenced distinctions.

⁹ Specifically, the applicants noted "[with the Klose] design, although there are no gaps at the outside edges of the shade strips 8, there is an increasingly large unscreened windshield section between the two shade strips 8, and this is clearly seen in FIG. 3 as well as being mentioned in the [sic] Klose in the paragraph bridging columns 3 and 4."

on the closure means was not the *sine qua non* of patentability. The applicants pointed to entirely different claimed subject matter.

The Ojima et al. patent and the Germann publication were similarly distinguished on grounds unrelated to diverging lateral sides on the closure device. Specifically, these documents were distinguished because they taught rollers at the bottom ends of an opening, such rollers could not be used with a vehicle shelter door opening. The applicants noted that these two documents actually taught trapezoidal openings, i.e., openings that flared from top to bottom. The applicants distinguished the art, however, because the documents required rollers at the bottom edges of these openings, a configuration that prevented these opening from being used in a vehicle shelter. The two documents were also distinguished because, like Klose, their panels allowed for gaps on their trapezoidal lateral sides and did not enclose the entire doorway opening. Again, there was no exclusive reliance on the closure device.

The distinctions continued. The Germann patent was distinguished, in part, because its roller was “located at the ‘large’ end of the guides” (emphasis in original). Here the applicants highlighted the roller as being absent from the art.

In short, the applicants distinguished over the art of record, not by relying solely upon diverging lateral sides, but by drawing attention to many different features, including rollers located at an edge of a door opening to allow for vehicle ingress and egress and panels that completely closed the opening.¹⁰

The multiplicity of features that distinguished the claimed subject matter was summarized in the following closing comment made by the applicant:

Therefore, amended Claim 1 distinguishes from Germann as the latter discloses a rectangular flexible cover which winds at its large end; from Ojima et al. and DE-38 41 139-a1 which teach tapered sun-blinds having wind-up rollers at their large ends; from Klose which requires two window shades and which leaves a significant gap therebetween; and from the Belgium

¹⁰ Distinguishing the prior art based on claimed features that were not related to another claim feature evidences that there has been no argument-based surrender of that other claim feature. Interactive Pictures Corp. v. Infinite Pictures, 274 F.3d 1371, 1379-80 (Fed. Cir. 2001).

Patent to Wellens which discloses a screen which is rectangular where it closes the window opening.¹¹

As is apparent from above, the guide means and the closure device were not the only distinguishing features. If anything, the entirety of the prosecution history suggests that diverging lateral sides on screens and tracks were arguably in the prior art in some form, just clearly not in a form invalidating the novel combination claimed by the applicants. The examiner's suggestion that diverging sides were the only features relied upon in the original prosecution is factually in error.

B. No "Clear and Un-mistakable" Surrender Exists.

Not only is the examiner's recapture position factually wrong, the case law does not support a finding of recapture in the present context.

1. Standard for Surrender by Argument

The patentee's right to a reissue patent is statutory. 35 U.S.C. §251. The discovery that the claims of the originally issued patent are too narrow is sufficient grounds to request a broadening reissue. In re James R. Amos, 953 F.2d 613, 616 (Fed. Cir. 1991).

There are limitations on broadening reissues. A patentee may not use a reissue application to recapture subject matter that he or she surrendered in an effort to obtain allowance of the original claim. In re Clement, 131 F.3d 1464, 1468 (Fed. Cir. 1997). This recapture rule precludes a patentee from trying to obtain claim coverage of subject matter that is of the same or broader scope as claims that were canceled in the original application. Ball Corp. v. United States, 729 F.2d 1429, 1436 (Fed. Cir. 1984). If the claims in the reissue application are narrower in all respects, however, then the recapture rule does not apply. MPEP §1412.02. Also, the recapture rule does not apply "in the absence of evidence that the applicant's amendment was an admission that the scope of that claim was not in fact patentable." In re Clement, 131 F.3d at 1469 (citations omitted). In determining whether

¹¹ Examiner points to this summary paragraph on page 4 of his January 29, 2003 Office Action. While rectangular covers were mentioned, the examiner fails to recognize that the applicants also pointed to window shades that left a gap and rollers at large ends as distinguishing over the prior art. Neither of these features related to the lateral edges of the closure device or the guide means.

there has been recapture, the prosecution history as a whole must be construed. *See, e.g., Eagle Comtronics, Inc. v. Arrow Comm. Lab., Inc.*, 305 F.3d 1303 (Fed. Cir. 2002).

The first step in applying the recapture rule is to determine whether and in what aspects the reissue claims are broader than the patent claims. *In re Clement*, 131 F.3d at 1468. If a reissue claim enlarges the scope of the claims in at least one respect, the reissue application is considered a broadening reissue.

The second step is to determine whether the broader aspects of the suggested, reissue claims relate to subject matter that was surrendered during prosecution of the original patent. *In re Clement*, 131 F.3d at 1468-69. For this inquiry, the Federal Circuit has stated:

Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable. *Id.*

Reissue claims that are broader in some respects and narrower in others may avoid the effect of the recapture rule. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996 (Fed. Cir. 1993). When the broadening of the reissue claim relates to an aspect of the claim that was never narrowed to overcome the prior art, for example, the recapture rule would not apply. *In re Clement*, 131 F.3d at 1471.

Generally, impermissible recapture involves claim amendments or cancellations. The Federal Circuit in *Hester Indus. v. Stein*¹² held that, in certain situations, arguments made to overcome prior art can also evidence an admission sufficient to give rise to impermissible recapture. 142 F.3d at 1481. In reaching this holding, the court in *Hester* cites *Warner-Jenkinson v. Hilton Davis Chem.*¹³ and analogizes the rule of argument-based surrender in the reissue context to the rule of surrender by argument in the prosecution history estoppel context. *Id.* In fact, the *Hester* decision rejected an argument that the two doctrines were not analogous. In linking the two, the *Hester* court applied the higher standard for argument-based prosecution history estoppel to argument-based surrender. In this higher standard, the Federal Circuit requires “clear and unmistakable surrender of subject matter”

¹² Footnote 3, *supra*.

¹³ 520 U.S. 17 (1997).

for there to be estoppel by argument. See, e.g., Eagle Comtronics, 305 F.3d at 1316; Pharmacia & Upjohn v. Mylan Pharm., Inc., 170 F.3d 1373, 1377 (Fed. Cir. 1999); Hester, 142 F.3d at 1482 (applying the rule that prosecution history estoppel may arise “by way of unmistakable assertions made to the Patent Office in support of patentability.”)

For such argument-based estoppel, the question is whether a “reasonable competitor” would have known that the subject matter was being relinquished. Hogunas AB v. Dresser, 9 F.3d 948 (Fed. Cir. 1993). Every statement made by a patentee during prosecution to distinguish a prior art reference does not create a separate estoppel. Arguments must be viewed in the context in which they are presented. Read Corp. v. Portec, (Fed. Cir. 1992). In particular, where a patentee disputes an examiner’s statement on the record, and makes no amendment based on the examiner’s statement, such statements usually would not be construed as a basis for argument-based prosecution history estoppel. Dow Chemical v. Sumitomo Chemical, 257 F.3d 1364, (Fed. Cir. 2001)(emphasis added).

2. Hester v. Stein

The facts in Hester may have met the high standard of “clear and unmistakable surrender” required under the law. The present facts, however, do not.

In Hester, the patentee focused repeatedly on only two claim limitations. Here, the applicant noted numerous distinctions. In Hester, the court noted that the applicant’s focus on these two limitations was repetitious, mentioning one twenty-seven times over six different responses to the Patent Office, the other limitation fifteen times. Here, the applicant did not focus on any one or two distinctions. Instead, the applicant used different features to distinguish over different prior art, including distinguishing over prior art that was not even asserted against the claimed subject matter.

The differences between the “clear and un-mistakable” showing of Hester and the present case are even more glaring. In Hester, the patentee argued that its two limitations were “critical” to patentability. Here, the applicants made no such argument and, indeed, the reliance upon different claim limitations to distinguish over the art suggests that none was critical to patentability. In Hester, the applicant filed two separate appeals to the Board of Patent Appeals and Interferences, and the Board expressly reversed the examiner’s rejection

stating that the two limitations argued by the patentee “were the primary bases indicated for patentability.” Hester, 142 F.3d at 1482. Here, there was a single office action prior to the notice of allowance. And none of the now-removed subject matter was listed as the reason for allowance in that notice of allowance.

As courts uniformly recognize, the rule of recapture is rooted on principles of equity. Id. at 1481. It cannot be fairly argued that Hester applies to the present facts. Although Hester met the requirements of clear and unmistakable surrender, the distinguishing remarks of the present case do not. No reasonable competitor could read the short prosecution history and the multitude of claim features mentioned therein and deduce that there has been “clear and un-mistakable” surrender of the subject matter now sought.

Applicants submit that a patentee is allowed to point out distinctions over the claimed subject matter and the prior art, without having such distinctions be blanketly considered surrender of any of the other allowable subject matter. To rule otherwise would not only vitiate the reissue process that arms patentees with a mechanism to correct for errors discovered after issuance, it could limit an applicant’s ability to insert alternative claims or broader claims during the original prosecution, or via continuation. Such outcomes cannot be fairly within the principles of equity that surround the reissue statute.

3. In the Prosecution History Estoppel Context, Courts Have Held that Similar Distinguishing Language Does Not Evidence Surrender.

Not only does an analysis of Hester show that the present applicants have not surrendered the proposed claim scope, the case law on argument-based prosecution history estoppel is equally supportive of this conclusion. The present case, for example, is more analogous to Eagle Comtronics v. Arrow Comm. Labs¹⁴ than to Hester v. Stein. In Eagle Comtronics, the applicant made repeated references to the location of its claimed seal in distinguishing that location from a location found in the prior art. Yet, the Federal Circuit found that:

¹⁴ 305 F.3d 1303 (Fed. Cir. 2002).

Eagles use of the specific claim language to define further the location of the claimed sealant does not amount to surrender of seals located elsewhere...

305 F.3d at 1316. In the similar case of G. Riles v. Shell, the Federal Circuit found again that:

During prosecution of the '918 patent, Riles attempted to distinguish the Graham reference with this statement: 'Graham does not describe a metal-to-metal bearing contact for transferring loads to the legs of the platforms.' This statement in context does not evince an unmistakable surrender of subject matter of any claim coverage beyond direct metal on metal contact.

G. Riles v. Shell Exploration & Prod. Co., 298 F.3d 1302, 1310 (Fed. Cir. 2002). In both cases, the applicants highlighted specific claim language (e.g., location and the type of engaging contact), but the Court properly recognized that the highlighting remarks did not meet the clear and un-mistakable surrender requirement for argument-based estoppel.

To summarize these holdings, remarks that merely highlight a distinguishing feature do not alone amount to surrender by argument under prosecution history estoppel. And per Hester, such remarks could not demonstrate surrender under the reissue statute either.

C. The Reissue Claims Recite Allowable Subject Matter

The applicants do not appeal the allowability of the claimed subject matter. The examiner has acknowledged that the claimed subject matter recites allowable subject matter and would be allowed, but for the recapture rejection. Per the examiner, "the prior art does not teach lateral stretching elastic members or laterally inwardly biasing means being movable with the curtain."

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VIII. CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that the recapture rejection is improper and should be removed and the case passed to allowance.

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APPENDIX A

1. (Issued claim; currently allowed) A roll-up closure device typically for use on vehicle shelters of the type defining at a front end thereof a door opening having lateral sides which diverge from top to bottom, comprising a pair of guide means adapted to be mounted to the vehicle shelter substantially at the lateral sides of the door opening and substantially parallel thereto thereby diverging from top to bottom an overhead roller means adapted to be rotatably mounted inside the vehicle shelter and substantially horizontally adjacent an upper end of the door opening, a flexible closure means adapted to be secured at a top end thereof to said roller means, at least a section of said flexible closure means having a shape which tapes in direction of said roller means and including diverging lateral side edges adapted to be engaged in said guide means, whereby a rotation of said roller means causes said flexible closure means to displace along said guide means and to wind around said roller means or to unwind therefrom for displacing said flexible closure means towards an open or a closed position thereof, respectively, wherein in said closed position, said section of said flexible closure means substantially completely closes the door opening.

2. (Issued claim; currently allowed) A closure device as defined in claim 1, wherein said roller means comprise winding means adapted to take up substantially triangular lateral end portions of said section such that when said flexible close means is in a rolled attitude around said roller means, said flexible closure means defines substantially concentric and cylindrical layers of varying axial width.

3. (Issued claim; currently allowed) A close device as defined in claim 2, wherein said roller means comprise a rotatable shaft with said top end of said flexible closure means being attached thereto, a pair of pulley means mounted at ends of said shaft, cable means being engaged to said pulley means and secured to said flexible closure means such that a rotation of said shaft and pulley means cause said cable means to displace thereby displacing said flexible closure means.

4. (Issued claim; currently allowed) A closure device as defined in claim 3, wherein each said pulley means comprise first pulley having an outwardly flaring bottom for receiving said lateral side edicts of said flexible closure means in an axially outwardly

staggered relationship therearound for maintaining substantially taut said cylindrical layers of said section in said rolled attitude.

5. (Issued claim; currently allowed) A closure device as defined in claim 4, wherein said cable means are connected to said pulley means such as to define closed loops, each said pulley means comprising a second pulley adjacent said first pulley, each said cable means being secured to both said first and second pulley such that a rotation of said pulley means causes said cable means to wind around one of said first and second pulleys and to unwind from another one of said first and second pulleys.

6. (Issued claim; currently allowed) A closure device as defined in claim 4, wherein said first pulley is frusto-conical shaped.

7. (Issued claim; currently allowed) A closure device as defined in claim 5, wherein a third pulley engaged by said cable means is provided at a lower end of each said guide means, whereby when said flexible closure means is displaced towards said closed position thereof, said flexible closure means and said cable means attached thereto unwind from said first pulleys with said cable means being also wound around said second pulleys while driving said flexible closure means downwardly along said guide means such as to substantially completely close the door opening; whereas when said flexible closure means is displaced towards said open position thereof, said flexible closure means and said cable means attached thereto wind around said first pulleys while upwardly pulling said flexible closure means along said guide means with said cable means being also unwound from said second pulleys.

8. (Issued claim; currently allowed) A closure device as defined in claim 5, wherein said second pulleys are slightly angled outwardly towards said guide means for cleanly receiving said cable means therein during rotation of said roller means towards said closed position.

9. (Issued claim; currently allowed) A closure device as defined in claim 5, wherein said cable means are each provided with binding means to ensure sufficient tension therein during rotation of said roller means.

10. (Issued claim; currently allowed) A closure device as defined in claim I, wherein said flexible closure means is provided with elastic means extending substantially

laterally at least adjacent said side edges to ensure that said flexible closure means remains substantially taut during rotation of said roller means.

11. (Issued claim; currently allowed) A closure device as defined in claim 10, wherein said guide means each comprise a tubular member adapted to be mounted to the lateral sides defining the door opening of the vehicle shelter and inwardly defining a longitudinal slot, said lateral side edges of said flexible closure means being engaged in said tubular members and inwardly extending therefrom through said slots, said elastic means maintaining said side edges substantially taut at said slots.

12. (Issued claim; currently allowed) A closure device as defined in claim 11, wherein each said guide means comprise sealing means mounted to said tubular member at said slot and at least on one side of said lateral side edges of said flexible closure means.

13. (Issued claim; currently allowed) A closure device as defined in claim 1, wherein reversible motor means are provided for driving said roller means.

14. (Issued claim; currently allowed) A closure device as defined in claim 1, wherein first detachable fastening means are provided on said flexible closure means inwardly of each said lateral side edge thereof for allowing said flexible closure means to be manually opened in the event that said roller means cannot be rotated or that said flexible closure means is jammed to said guide means.

15. (Issued claim; currently allowed) A closure device as defined in claim 14, wherein second detachable fastening means are provided for securing said flexible closure means in an open position when having been manually opened using said first detachable fastening means.

16. (Issued claim; currently allowed) A closure device as defined in claim 15, wherein said first detachable fastening means comprise zippers, and wherein said second detachable fastening means comprise strap means.

17. (Issued claim; currently allowed) A closure device as defined in claim 1, wherein said flexible closure means extends substantially planarly across the door opening when in said closed position.

18. (Issued claim; currently allowed) A closure device as defined in claim 11, wherein said lateral side edges of said flexible closure means are each secured opposite

said elastic means to a sliding block means engaged in said tubular member for ensuring that said flexible closure means can displace along said guide means even with forces applied inwardly on said lateral side edges by said elastic members.

19. (Issued claim; currently allowed) A closure device as defined in claim 18, wherein each said sliding block means comprises a pulley engaged by said cable means and mounted at a distance a lower end of said lateral side edge of said flexible closure means being mounted to said lower end of said sliding block means, said lower end of said sliding block means being adapted to extend in said guide means at least close to the ground in said closed position such that a lower edge of said flexible closure means extends at least close to the ground whereby said pulley, being mounted fairly above the ground, and said cable means are not as vulnerable to jamming due to ice built-ups with said sliding block means ensuring that said flexible closure means extends firmly downwards to the ground.

APPENDIX B

20. (Added; Amended, currently rejected under recapture) A roll-up closure device adapted to be disposed adjacent a door opening and movable between blocking and unblocking position relative thereto, and comprising:

a roller adapted to be rotatably mountable adjacent an upper end of the door opening:

a curtain adapted to be secured at a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively:

guide members adapted to be disposed at the lateral sides of the door opening:

guide engagement members couplable to the curtain for movement therewith and engageable with the guide members to restrict their movement toward the curtain center: and

a discrete elastic member coupled to the curtain for movement therewith and extending laterally across the curtain, and disposed such that the elastic member can be stretched laterally between the restricted guide engagement members.

21. (Added; currently rejected under recapture) The device of claim 20, wherein opposed ends of the elastic member are coupled to the curtain, and the restricted guide engagement members are coupled to the lateral edges of the curtain, an increased lateral separation of the guide engagement members exerting a pulling force on the curtain tending to stretch the elastic member.

22. (Added; currently rejected under recapture) The device of claim 20, wherein the elastic member can be stretched to allow the curtain to yield to an applied external force without rupturing.

23. (Added; currently rejected under recapture) The device of claim 20, wherein the guide engagement members are cables extending along the lateral edge of the curtain and received in a pocket formed therein.

24. (Added; currently rejected under recapture) The device of claim 20, wherein the guide engagement members are blocks coupled to the lateral edges of the curtain at approximately the same height as the elastic member.

25. (Added; currently rejected under recapture) The device of claim 20, and including a second elastic member coupled to the curtain for movement therewith and extending laterally across the curtain such that the second elastic member can be stretched between the restricted guide engagement members.

26. (Amended; added; currently rejected under recapture) A roll-up closure device adapted to be disposed adjacent a door opening and movable between blocking and unblocking position relative thereto, and comprising:

a roller adapted to be rotatably [sic] mountable adjacent an upper end of the door opening;

a curtain adapted to be secured at a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively;

guide members adapted to be disposed at the lateral sides of the door opening;
and

laterally inwardly biasing means for maintaining the curtain taut, and for allowing the curtain to yield depth-wise for an applied force, wherein the laterally inwardly biasing means is movable with the curtain between the blocking and unblocking positions.

27. (Added; currently rejected under recapture) The device of claim 26, wherein the laterally inward biasing means comprises:

guide engagement members couplable to lateral edges of the curtain for movement therewith and engageable with the guide members to restrict their movement toward the curtain center; and

a discrete elastic member coupled to the curtain for movement therewith and extending laterally across the curtain, and disposed such that the elastic member can be stretched between the restricted guide engagement members.